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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,988	04/17/2006	Marcello Memmolo	19725	8467
272 7590 02/18/2010 SCULLY, SCOTT, MURPHY & PRESSER, P.C. 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
SINGH, SUNIL K				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
02/18/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/575,988

**Applicant(s)**

MEMMOLO ET AL.

**Examiner**

Sunil K. Singh

**Art Unit**

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to Applicant's amendments filed on 12/07/2009

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13, 14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 2004/0096804) in view of Porter et al. (US 2004/0101808).

Vogt discloses a dental implant and (4A-4B) and a transfer part of a dental implant (3 in Figs. 3a-3c) that includes: a free extension (33) at one end of a transfer part that is capable of coupling a rotational tool and a first radial groove adjacent to the free extension that is capable of receiving a securing element (Figs. 3a-3c); a clamping portion (30); a second radial groove (331) that is capable to directly engage with the dental implant; a force transmission element (330) having an octagonal surface [0088]; and a clamp ring (332) in its non assemble state having a gap that is assembled in the radial groove (331) (Fig. 3b); an extension (30) having an outer polyhedral (Figs. 3a-3c) and a fixing portion (32) positioned between the extension (33) and the clamping portion (30) (Figs. 3a-3c). Vogt further discloses a combination of a transfer part (as previously described) and an inner ampule (Figs. 7a-8c) where the inner ample includes: a laterally

open upper fixing portion (40) with indentions (42) that enlarges radially toward a large surface recess (43) (also shown in Fig. 8a); a lower fixation portion having a laterally open indentation towards the recess and adapted to receive the implant (Fig 8c).

Furthermore, Vogt discloses an ampule that includes: the indentation of the upper fixing portion (402) is trumpet like (Figs. 7a-7b) and the lower fixing portion is configured in the form of two support wings (Fig. 8c); the indentation is adapted to receive a fixing portion of the transfer part (Fig. 7e and 8c) and where lower fixing portion is adapted to receive an implant shoulder (Fig. 8c); and where the recess (61) is formed with rounded corners at its lower portion opposite to the indentation (Fig. 8c). However, Vogt fails to disclose a dental implant having an undercut dimensioned suitably for clampingly receiving a clamping ring; wherein the undercut corresponds the radial groove of the transfer part; and wherein the clamping portion connects to the dental implant via clamp ring.

Porter teaches a dental implant (10) that includes an undercut (110) dimensioned suitably for clampingly receiving a clamping ring (116) and wherein the clamping ring allows the clamping portion to connect to the dental implant (Fig. 6D); and wherein the undercut (110) corresponds to the radial groove (112) of the transfer part (64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Vogt, to include an implant having an undercut dimensioned suitably for clampingly receiving a clamping ring, as taught by Porter, in order to provide an anti-rotational locking system where the implant is lockingly secured onto the transfer part of the apparatus.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vogt et al. (US 2004/0096804) in view of Porter et al. (US 2004/0101808) and further in view of Sutter et al. (US 5,078,605).

Vogt/Porter discloses the invention substantially as claimed except for a clamp ring being formed from polyether ether ketone (PEEK).

Sutter teaches a ring (31) that is inserted in a groove (25d) that is made of PEEK in order to provide a material non-toxic, biocompatible, and capable of being easily processed (Column 5, Lines 44-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Vogt/Porter by forming a ring made of PEEK, as taught by Sutter, in order to provide a ring that is non-toxic and capable of easily being processed.

### ***Response to Arguments***

Applicant's arguments filed 12/07/2009 have been fully considered but they are not persuasive. In response to Applicants arguments that the Examiner has mis-labeled the free-extension as element 30; the Examiner has corrected the numerical mistake. However, the extension could also be labeled as element 30 because the structure of such an element is the same as disclosed in the claims. The Applicant also alleges that the present invention is a one-piece transfer part; however, such limitations are not being claimed.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment

on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Applicant further argues that the ring does not have a gap when its in a non-ensemble state. However, the Examiner respectfully disagrees. The Examiner points out that the ring is an O-ring (thus have a donut shape with a hole in the middle). The Examiner is interpretation of the hole is to be equivalent to the claimed "gap."

In response to applicant's argument that Porter and Vogt is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it is the same field of endeavor in that they are both connection means for connecting an object to an implant. Furthermore, they solve the same pertinent problem by providing a locking means that secures the implant to the object (i.e. transfer part).

Applicant further argues that it is improper to combine the two references is improper since one reference (Vogt) teaches the radial groove engaging the tool outside the implant and Porter teaches the undercut is formed within the implant. However, looking at Figure 5b of Vogt, the Examiner points out an undercut (301) formed within

the dental implant. To modify Vogt to include a securing element such as a clamp ring on the radial groove (301) to securely connect the transfer part to the implant is taught by Porter (see rejection above). Thus, Vogt does indeed teach an undercut formed within the dental implant as shown in Figure 5b. An undercut is defined to be a "groove" which is clearly shown as element 301.

The Applicant further argues that Porter is not used as a securing device but rather indicating device to ensure for proper positioning. Although, the ring is used as an indicating device, Porter also explains that the ring is used to retain the abutment to the dental implant. Thus, Porter illustrates that the ring is used for the same purpose as the applicant's ring and also has an added beneficial purpose.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil K. Singh whose telephone number is (571) 272-3460. The examiner can normally be reached on Monday-Friday (Increased Flex Schedule).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris L. Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/12/2010

/Sunil K Singh/  
Examiner, Art Unit 3732

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732